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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/003,756	11/01/2001	Carsten Schuh	P99,0663-01	8592
7590	10/06/2004			
SCHIFF HARDIN & WAITE Patent Department 6600 Sears Tower 233 South Wacker Drive Chicago, IL 60606			EXAMINER NGUYEN, DONGHAI D	
			ART UNIT 3729	PAPER NUMBER

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,756

Applicant(s)

SCHUH ET AL.

Examiner

Donghai D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/295,917.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The proposed reply filed on June 18, 2004 has been entered as record.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrases “that is to be passivated with a plastic coating” (claim 23, lines 3-40) and “to provide the plastic coating” (claim 23, last line) are vague and indefinite. It is unclear exactly how the plastic coating is formed and applied to the outer surface of the component. Furthermore, the phrase “a pressing device” (claim 25, line 3) is vague since it is uncertain that it is the same or different pressing device as recited in claim 24.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) The invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1, 3, 5, 7, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Baumbach.

Regarding claims 1 and 11, Baumbach discloses a method for producing an electrical or electronic component, the method comprising the steps: providing a body (4/6) of plastic material for accommodating and encapsulating the surface of the component (18), inserting the component into the plastic body (Fig. 1), joining the surface of the component to the plastic body by applying pressure to the body of plastic material (Figs. 5-6 and col. 2, lines 29-44).

Regarding claims 3 and 5, see Fig. 1

Regarding to claim 7, the body 4 or 6 is having a stabilizing element (it has a resilient characteristic, see col. 2, line 4).

6. Claims 1, 3-5 and 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,148,077 to Grawey et al.

Regard to claims 1 and 11, Grawey et al disclose a method for producing an electrical or electronic component, the method comprising the steps: providing a body (220/222/224) of plastic material for accommodating and encapsulating the surface of the component (202), inserting the component into the plastic body (Fig. 2), joining the surface of the component to the plastic body by applying pressure to the body of plastic material (col. 5, lines 29-33).

Regarding claims 3- 4, see figs. 1-2.

Regarding claim 5, Grawey et al disclose the body comprises at least two individual parts (224 and 222), which are connected to the surface of the component.

Regarding claim 7, Grawey et al disclose the body comprises at least one stabilizing element (Col. 6, lines 35-39).

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Regarding claims 8 and 9, Grawey et al disclose the body comprises a substance for mediating adhesion and the surface of the component comprises a substance for mediating adhesion (222).

Regarding to claim 10, Grawey et al disclose the body comprises at least one plastic that is selected from the group consisting of solid silicones and fluorinated silicone elastomer (Col. 2, lines 56-63).

7. Claims 1-4, 8, 11, and 23-24 are rejected under 35 U.S.C. 102(a) as being anticipated by US Patent 5,861,577 to Tamura et al.

Regard to claim 1, Tamura et al disclose a method for producing an electrical or electronic component, the method comprising the steps: providing a body (3) of plastic material (Col. 8, lines 13-17) for accommodating and encapsulating the surface of the component (2); inserting the component into the plastic body (Fig. 1, col. 10, lines 2-4); and joining the surface of the component to the plastic body by applying pressure to the body of plastic material (Figs. 1, 2, and col. 10, lines 25-38).

Regarding claim 2, see Col. 19, lines 14-15.

Regarding claims 3-4, see fig. 2.

Regarding claim 8, see col. 8, lines 10-17.

Regarding claim 11, Figs 1-3 show the device (4) for generating pressure.

Regarding claim 23, Tamura et al disclose a method for producing an electrical or electronic component comprising the steps of: providing a component (3) with an outer surface that is to be passivated with a plastic coating 9 (Fig. 2), molding a plastic material to form a

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tubular body having an outside surface and a hollow space with an inside surface that is inverse in form to the outer surface of the component (Col. 19, lines 14-15), inserting the component into the hollow space of the tubular body (Fig. 1, col. 10, lines 2-4), and then applying pressure to the body to join the inside surface of the hollow space to the outer surface of the component to provide the plastic coating (Figs. 1, 2, and col. 10, lines 25-38).

Regarding claim 24, Figs 1-3 show the device (4) for generating pressure in the step of applying pressure on the outside surface of the body to create the pressure to join the inside surface of the hollow space on the outer surface of the component.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6, 12-14, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Grawey et al or Tamura et al in view of Applicants' Admitted Prior Art.

Grawey et al or Tamura et al disclose al the claimed invention of producing the electronic or electrical component except the body comprises at least partially cross-linked plastic and the pressure is generated by the cross-liking of the plastic of the body which is cross-linked thermally or by exposure for improving the elasticity of the silicon elastomer (See Spec page 2, line 25 to page 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify either Grawey et al or Tamura et al to have the body

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comprising cross-link plastic by thermally or exposure as taught by Admitted Prior Art for improving the elasticity of the silicon elastomer.

Response to Arguments

3. Applicant's arguments filed June 18, 2004 have been fully considered but they are not persuasive.

Applicants argue that Baumbach does not teach or suggest the pressure joins the surface component to the body of plastic material and is silent about any passivation with a plastic coating. The Examiner respectfully disagrees. Figs. 4-6 and Specification col. 2, lines 29-44 of Baumbach disclose the pressure (causing deformed the body of plastic material) joins the surface component (18) to the body of plastic material (4). In regard to the recitation that "passivated with a plastic coating" in the preamble does not effect the limitation of the claim since the portion of the claim following the preamble is a self-contained description of the structure is not depending or completeness upon the introduction clause. *Kropa v. Robie*, 88 USPQ (CCPA 1951).

In response to Applicants' argument that Grawey et al do not teach or suggest the claimed invention, The Examiner disagrees since Grawey et al disclose a body (220/22/224) of plastic material (silicone); inserting the component (202) into the body; and joining the component to the body (Col. 5, lines 29-33) by pressure.

4. Applicant's arguments with respect to claims 1-14 and 23-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donghai D. Nguyen whose telephone number is (703) 305-7859. The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN



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